

REMARKS

Claims 1-7 are currently pending in the application. Claim 1 has been amended by moving the word “and” from line 24 to line 26. Claim 5 has been amended to correct the typographical error made in the amendment filed March 30, 2004. No new matter has been added.

Claims 5-7 have been rejected as indefinite under 35 U.S.C. § 112, second paragraph, on the basis that Claim 5 was written as depending from itself. The confusion results from a typographical error in Applicants’ response to the previous office action, which has been corrected by this amendment as required by the Examiner. As amended, the rejection under 35 U.S.C. § 1112, second paragraph, has been overcome, and withdrawal of the rejection is therefore respectfully requested.

Rejection of Claims 1-7 Under 35 U.S.C. § 101

Claims 1-7 have been rejected under 35 U.S.C. § 101 as directed to nonstatutory subject matter. Applicants traverse on the basis that the claimed invention is patentable as a business method under *State Street Bank and Trust Co. v. Signature Financial Group Inc.*, 47 U.S.P.Q2d 1596, 1602 (Fed. Cir. 1998) (“Since the 1952 Patent Act, business methods have been, and should have been, subject to the same legal requirements for patentability as applied to any other process or method.”) According to the Examiner:

For a claimed invention to be statutory, the claimed invention must be within the technological arts For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. (Office Action at 3) Applicants respectfully submit, however, that business management is a useful art and not a liberal art and that there is no independent “technological arts” rejection under 35 U.S.C. § 101. *See In re Toma*, 197 U.S.P.Q. 852, 857 (C.C.P.A. 1978).

The Examiner has also incorrectly found that Claims 1-7 do not produce a useful, concrete, and tangible result: “The steps of claims 1-7 could be carried out solely in the

mind of a human and therefore do not necessarily apply, involve, use, or advance the technological arts.” (Office Action at 3) Applicants traverse on the basis that the claims are inherently means-plus-functions claims and the Specification clearly describes the use of automated data processing means. (*See* Specification at page 4, line 34 – page 5, line 12; at page 21, line 12 (“data mining techniques”); and at page 21, lines 15-17)

Applicants therefore respectfully submit that rejection under 35 U.S.C. § 101 is unwarranted and request reconsideration and allowance of Claims 1-7.

Conclusion

In view of the foregoing, it is respectfully requested that the application be reconsidered, that Claims 1-7 be allowed, and that the application be passed to issue. In the alternative, it is requested that this amendment be entered for purpose of appeal.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

A provisional petition is hereby made for any extension of time necessary for the continued pendency during the life of this application. Please charge any fees for such provisional petition and any deficiencies in fees and credit any overpayment of fees to Deposit Account No. 09-0458 (IBM-Fishkill).

Respectfully submitted,



C. Lamont. Whitham
Registration No. 22,424

Whitham, Curtis & Christofferson, P.C.
11491 Sunset Hills Road, Suite 340
Reston, VA 20190
703-787-9400
703-787-7557 (fax)